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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,350	01/19/2001	Takashi Suda	1046.1231 (JDH)	7142
21171 7590 11/23/2007 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER DIVECHA, KAMAL B	
			ART UNIT 2151	PAPER NUMBER
			MAIL DATE 11/23/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/764,350

Applicant(s)

SUDA, TAKASHI

Examiner

KAMAL B. DIVECHA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 20070615
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claims 1-4, 6 and 8-21 are pending in this application.

Claims 5 and 7 were previously cancelled.

Response to Arguments

Applicant's arguments filed September 11, 2007 have been fully considered but they are not persuasive.

a. Applicants respectfully submit that the claims clearly recite hardware elements in response to 35 U.S.C. 101 rejection (remarks, pg. 7).

In response to argument [a], Examiner respectfully disagrees.

Independent claim 1 recites:

“An apparatus for managing addresses of websites comprising:
an address list...
a monitoring section... and
an updating section...”

As indicated in the previous office action (Final rejection, pg. 3), the “monitoring section”, “updating section” and “address list” can be implemented as a computer program or software code (see applicant specification, pg. 28: browser assistant software).

Furthermore, the specification is clearly evident to disclose the monitoring section and the updating section as computer programs (applicant specification, pg. 7-8, 12).

An address list can merely be a data structure associated with a computer program.

As acknowledged by the applicant, MPEP 2106 (IV)(B)(2)(b)(ii) indicates that if a claim identifies the physical structure of a machine in terms of its hardware or hardware and software combination, the claim defines a statutory product.

In the instant case, the claim clearly fails to identify even a single physical structure of a machine such as a processor, memory, etc.

As such, the claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

b. Neither Li nor Chung, alone or in combination, discloses or suggests, "...if no input is supplied over a predetermined time period with respect to reference to any of the web sites, said updating section tries to access each of the addresses contained in said address list, and deletes an address from the said address list if the number of times failure has occurred continuously becomes to a predetermined threshold value by failure of said tries," as recited in claim 1 (remarks, pg. 8-9).

In response to argument [b], Examiner respectfully disagrees.

Initially, Li discloses the claimed subject matter, except for the fact "updating section tries to access each of the address contained in said address list, and deletes an address from the said list if the number of times failure has occurred continuously becomes to a predetermined threshold value by failure of said tries, as evidenced by the following figure, through the features such as "automatically adding bookmarks when certain condition is met, automatically deleting bookmarks that have not been visited based on the certain condition, automatically deleting dead bookmarks, etc." (See col. 11 L18-45).

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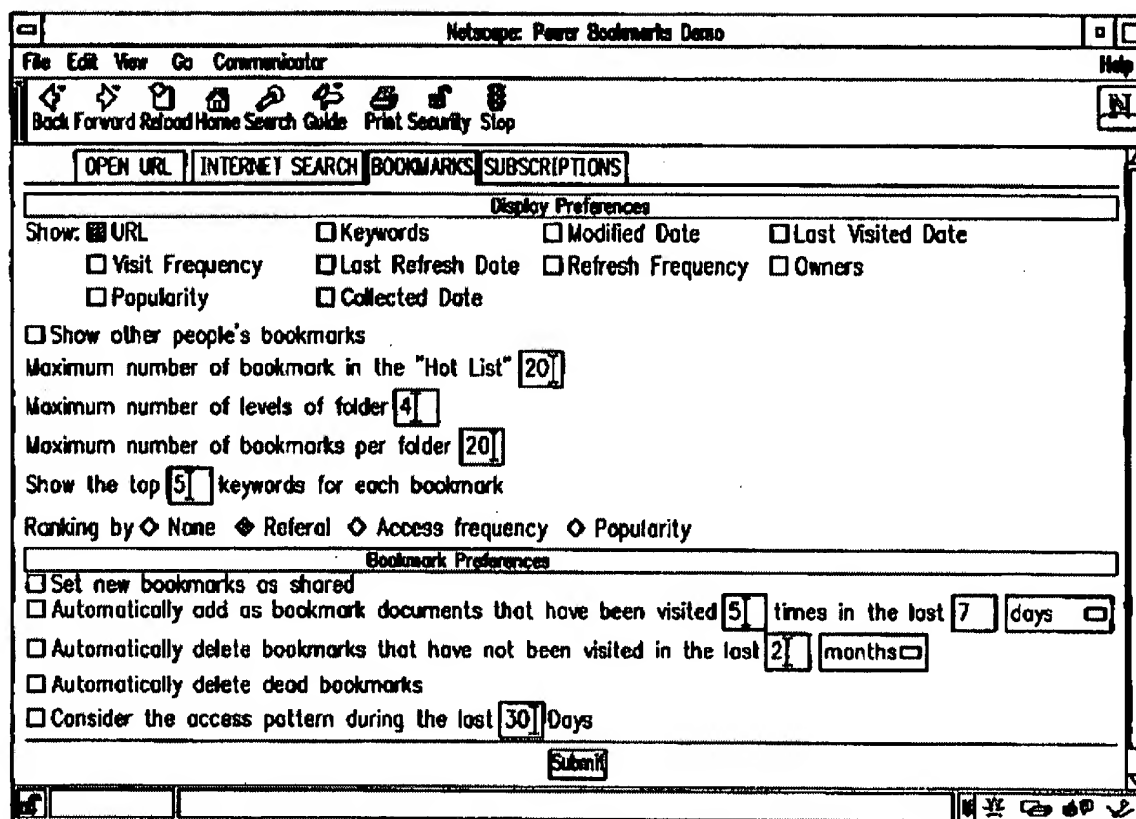


FIG. 19

In other words, Li does not try to access each of the address from the list before deleting the address from the address list and delete the address from the list if the number of failure becomes equivalent to a predetermined threshold, i.e. Li does not disclose a retry mechanism for confirming that the un-accessed address from the list is in fact inactive.

Chung clearly discloses the retry mechanism, i.e. a process of retrying the identifiers, i.e. addresses, for which a response is not received within a predetermined time period, in an event of an access failure caused due to reasons such as congestion, server overload, server failure, and the like (column 7 lines 37-65).

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The retry mechanism of Chung allows the user to specify the retry parameters, including a timeout period, a retry period, and a maximum number of retries for each of the network service identifiers, i.e. addresses (col. 7 L65 to col. 8 L26).

In other words, Chung teaches a process of trying to access an address a predetermined number of times in an event of a failure, i.e. Chung teaches the process of confirming whether the identifier is active or not by retrying to access the identifier a number of times.

Logically speaking, Chung discloses the process of determining if the number of times failure with respect to each of address has occurred continuously becomes to a predetermined threshold value by failure of said tries by utilizing the retry mechanism.

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Li in view of Chung in order to access each of the address from the list in an event no input is supplied in reference to an address, before deleting the address from the address list and delete the address from the list if the number of failure becomes equivalent to a predetermined threshold, since Chung discloses a mechanism for attempting to access the address a predetermined number of times.

As such, the combination of Li and Chung discloses the feature as set forth above.

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c. Neither Lu nor Chung, alone or in combination, discloses or suggests, "recording a frequency of access to each website address list in a website address list; and adding a particular website address to the website list when the frequency of access to said particular website address becomes equal to a predetermined threshold value, as recited in claim 22 (remarks, pg. 9).

In response to argument [c], Examiner respectfully disagrees.

Initially, the newly added claim 22 fails to meet the requirement under the 35 U.S.C. 112, first paragraph (See 35 U.S.C. 112, first paragraph rejection as set forth herein).

Furthermore, the reproduced figure above, i.e. figure 19, is clearly evident to disclose adding a particular website address to the website list when the frequency of access to said particular website address becomes equal to a predetermined threshold value.

For example: the feature that automatically adds bookmark document, i.e. addresses that have been visited 5 times in the last 7 days.

In this case, the access frequency is 5 and the predetermined threshold value is 5.

As per recording a frequency of access to each website in a website address list, Li's Powerbookmarks stores the access frequency in a table at which the user access the document so that the personalized service can be provided to the user (See col. 5 L34 to col. 6 L31).

Information Disclosure Statement

The information disclosure statement (IDS) submitted on June 15, 2007 was filed after the mailing date of the non-final office action on May 29, 2007. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1-4, 6, 8-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Independent claim 1 recites:

“An apparatus for managing addresses of websites comprising: an address list... a monitoring section... and an updating section...”

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

In other words, the claim lacks a positive recitation of a hardware element enabling the claim and/or the apparatus to be interpreted as a machine.

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The claim, as recited, can be implemented as a program and/or software code (see applicant specification, pg. 28: browser assistant software), a non-statutory subject matter for at least failing to fall into any of the four enumerated categories of the statutory subject matter as set forth above.

Applicant is therefore advised to include a positive recitation of a hardware element of the apparatus.

Claims 2-4, 6 and 8-18 are rejected for the same reasons as set forth in claim 1.

Note: A recording medium as in claim 20 is equivalent to hard disk, CD-ROM or a floppy disk (applicant's specification, pg. 28).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 22 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Newly added claim 22 recites:

A method for managing website addresses, comprising:

recording a frequency of access to each website address list in a website address list; and
adding a particular website address to the website list when the frequency of access to said particular website address becomes equal to a predetermined threshold value.

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The originally filed specification fails to provide a support for the newly added claim, more specifically, for the limitations of “recording a frequency of access to each website address list in a web site address list” and “adding a particular web site address to the website address list...”

The claim is directed towards recording the access frequency on the website address list and adding the address to the same web site address list based on the access frequency.

The specification, as originally filed, clearly fails to teach, disclose or even suggest recording the frequency on the website address list, and adding the address to the same website address list based on the frequency.

In fact, the specification teaches and discloses the usage of URL list comprising the list of URLs and the table 24 that records the access and/or failure frequency (See original specification, pg. 19-20 and pg. 22 and fig. 2).

Moreover, the specification explicitly discloses referring to the table 24 for addition or deletion of the urls to and from the URL list (See specification, pg. 22, fig. 2 item #22, 24).

In other words, the URL list and the table 24 are two different data structures, and the address is added to the URL list based on the information in table 24, as set forth above.

Hence, the newly added claim contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al. (hereinafter Li, US 6,631,496 B1).

Li discloses a method for managing website addresses (col. 2 L36-46), comprising:

recording a frequency of access to each website address in a list (col. 5 L34 to col. 6 L31, col. 10 L14-61: list is maintained at the proxy); and
adding a particular website address to the website address list when the frequency of access to said particular website address becomes equal to a predetermined threshold value (pg. 10 L14-61, fig. 19).

However, Li does not disclose recording a frequency of access to each website address in a website address list.

But it would be obvious to a person of ordinary skilled in the art at the time the invention was made to modify (if necessary) Li in order to record the access frequency in a website address list, i.e. same list as the bookmarked list, since Li teaches recording the frequency initially.

One of ordinary skilled in the art would have been motivated because it would have provided automated book-marking services (Li, col. 6 L5-30).

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4. Claims 1-4, 6 and 8-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al. (hereinafter Li, US 6,631,496 B1) in view of Chung et al. (hereinafter Chung, US 6,012,090).

As per claim 1, Li explicitly discloses an apparatus for managing addresses of websites (fig. 19 and col. 1 L56 to col. 2 L57) comprising:

an address list containing addresses of website (col. 2 L36-46 to col. 3 L7, col. 11 L12-45);

a monitoring section monitoring a state of user references to web sites (col. 2 L36 to col. 3 L7, col. 10 L14-67); and

an updating section updating the contents of said address list according to the state of user references monitored by said monitoring section, said updating including deleting from and adding to the contents of said address list according to the state of user references wherein said deleting occurs based on access failure of a website, and wherein said updating section has a line connected for reference to the website (a connection capable of initiating the identifier), and if no input is supplied over a predetermined time period with respect to reference to any of the web sites, said updating section tries to access each of the addresses contained in said address list and deletes an address from said address List (col. 7 L15 to col. 8 L60, col. 10 L14 to col. 11 L45, and fig. 19: clearly summarizes Li's invention).

However, Li does not disclose a means wherein, if the number of times the access failure has occurred with respect to one of the addresses contained in said address list becomes equal to a predetermined threshold value, said updating section deletes the one of the addresses from said

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address list, said updating section tries to access each of the addresses contained in said address list and deletes an address from said address list if the number of times failure has occurred continuously becomes equal to a predetermined threshold value by failure of said tries (i.e. a typical “retry mechanism” before deleting the addresses from the list, or testing the number of times access failure has occurred before deleting the addresses from the list as per applicant).

Chung explicitly discloses a retry mechanism comprising determining, whether the number of times the access failure has occurred with respect to one of the addresses/identifiers contained in said address list or group becomes equal to a maximum number of retries, i.e. predetermined threshold value, by accessing the identifiers, i.e. addresses, a maximum number of times (col. 7 L38 to col. 8 L9: RETRY mechanism with a maximum number of retries in an event of a access failure, col. 5 L18-43).

Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Li in view of Chung, in order to delete the addresses from the list if the number of times failure has occurred becomes equal to a predetermined threshold value by failure of said tries (i.e. utilizing a retry mechanism before deleting the address).

One of ordinary skilled in the art would have been motivated because the retry mechanism is a widely available technique for ensuring the availability and/or status of the website (Chung, col. 7 L65 to col. 8 L10, col. 3 L23-30).

As per claim 2, Li discloses the apparatus further comprising a connection section accessing to an address contained in said address list in case the address is designated (i.e. incase the address is selected for access, col. 1 L56-67, col. 4 L21-34, col. 5 L34-53, col. 6 L4-21).

As per claim 3, Li discloses the apparatus wherein said monitoring section records the frequency of access to the address of each web site as a content of said state of references, and said updating section adds, to said address list, an address with an access frequency reached to a predetermined threshold value (i.e. adding the address into the list of addresses based on its popularity or access times, col. 10 L14-30 and fig. 19).

As per claim 4, Li discloses the apparatus wherein said monitoring section records the frequency of access to the address of each web site as a content of said state of references, and said updating section deletes, from said address list, any of the addresses in said address list with an access frequency lower than a predetermined threshold value (fig. 19 and col. 11 L3-34).

As per claim 6, Li discloses an apparatus wherein the access frequency with respect to each of the web sites is updated each time access the web site results in success, and wherein when the access frequency is updated, said updating section makes a determination whether or not the access frequency has reaches the predetermined threshold value (col. 10 L14 to col. 11 L45 and fig. 19).

As per claim 8, Li discloses the apparatus further comprising a supply section supplying a user with a setting window to enable the user to set the predetermined threshold value (col. 14 L30 to col. 15 L34 and fig. 19).

As per claim 12, Li discloses the apparatus wherein said updating section is activated when an operating system controlling said address management apparatus is activated (fig. 19, col. 3 L3-5).

As per claim 15, Li discloses an apparatus wherein the access frequency is the number of occurrences of access in a unit number of days, and said updating section is activated when the date is changed (col. 5 L54-67 and fig. 19).

As per claim 18, Li discloses the apparatus wherein said updating section is activated when the setting of the predetermined threshold value is changed by the user (fig. 19).

As per claims 9-11, 13, 14, 16, 17 and 19-21, they do not teach or further define over the limitations in claims 1-4, 6, 8, 12, 15 and 18. Therefore claims 9-11, 13, 14, 16, 17 and 19-21 are rejected for the same reasons set forth in claims 1-4, 6, 8, 12, 15 and 18.

Additional References

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Peerey et al., US 5,960,429: Multiple Reference Hotlist for identifying frequently retrieved web page.
- b. Bates et al., US 6,100,890: Automatic Bookmarks.

Conclusion

Please Note: The teachings of the prior art shall not be restricted and/or limited to the citations by columns and line numbers, as specified in the rejection. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its

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entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner, in order to move prosecution forward.

In the case of amendments, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and support, for ascertaining the metes and bounds of the claimed invention.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAMAL B. DIVECHA whose telephone number is 571-272-5863. The examiner can normally be reached on Increased Flex Work Schedule.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kamal Divecha/

Kamal Divecha
Art Unit 2151
November 13, 2007.


JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100